



DOCKET NO. 17008DIV5CON/AB

PATENT

TECH CENTER 1600/2900

AUG 14 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of
R. BurkSerial No: 10/087,867
Conf. No. 9687

Filed: February 28, 2002

For: CYCLOPENTANE(ENE)
HEPTENOIC OR HEPTANOIC ACIDS
AND DERIVATIVES THEREOF USEFUL
AS THERAPEUTIC AGENTS

Group Art No.: 1626

Examiner: Robert Gerstl

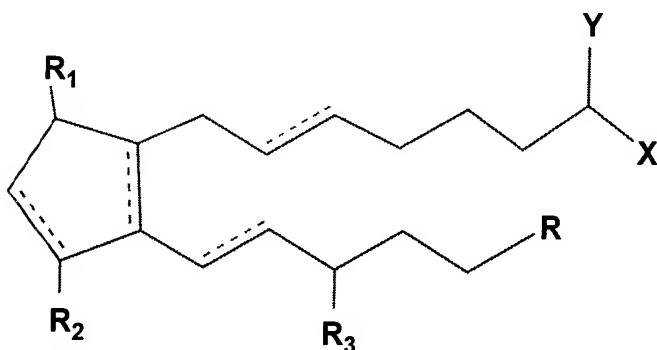
REPLY UNDER 37 CFR § 1.111Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated May 20, 2002, the applicants offer the following arguments.

REMARKS

The present invention relates to a method of treating incontinence, immune regulation, disorders of bone metabolism and renal dysfunction which comprises applying to a patient in need of treatment, an amount sufficient to treat such disorders of a compound of formula (I)



wherein either the cyclopentane(ene) radical or the α or ω chain may be unsaturated and the dotted lines represent the presence or absence of a double bond; R is a hydrocarbonyl radical or a heteroatom substituted hydrocarbonyl radical comprising up to ten carbon atoms

and one or more of the hydrogen or carbon radicals in said hydrocarbyl radical may be substituted with oxygen, sulfur, nitrogen, phosphorus or halogen; R₁, R₂ and R₃ are selected from the group consisting of hydroxy, hydrocarbyloxy and heteroatom substituted hydrocarbyloxy wherein said hydrocarbyl radical comprises up to 20 carbon atoms; Y represents 2 hydrogen radicals or an oxo radical and X represents a hydroxyl, a hydrocarbylcarboxy, a hydrocarbyloxy, an amino or a mono or dialkyl amino radical; provided, however, at least one of R₁, R₂ and R₃ is a hydrocarbyloxy or heteroatom substituted hydrocarbyloxy radical.

The Examiner has rejected claim 1, the only pending claim, under 35 USC § 102(b), as anticipated by Floyd. In particular, the Examiner argues that Compound 561 of Floyd is disclosed for treating renal dysfunction, i.e. as a salt or water retention agent or diuretic. The Examiner characterizes Compound 561 as a 11-methoxy derivative, which is correct. However, this compound is also a 9-oxo derivative, which is excluded by claim 1 of the present patent application. In particular, R₁, which represents the 9 position is not an oxo group. Thus, this limitation excludes compound 561 from the invention as defined by claim 1.

Moreover, claim 1 is not obvious over Floyd. That is, there is no motivation to modify the 9-oxo derivative of Floyd to the definition required for R₁ of claim 1.

In view of the above, it is believed that the claim is patentable over the prior art cited by the Examiner.

Respectfully Submitted,

RJ Baran

Robert J. Baran

Registration No. 25,806

Telephone: 714/246-4669

Telecopier: 714/246-4249

Allergan, Inc.
ROBERT J. BARAN (T2-7H)
2525 Dupont Drive
Irvine, CA 92612-1599

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE WITH SUFFICIENT POSTAGE AS EXPRESS MAIL (LABEL NO. EL897855934US) IN AN ENVELOPE ADDRESSED TO: BOX AMENDMENT-NON FEE, ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231 ON _____ (Date) Printed name of person making deposit: Bonnie Ferguson
Signature: _____ Date: _____



08-12-02

1626

DOCKET NO. 17008DIV5CON3 (A) PATENT

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AS THERAPEUTIC AGENTSCERTIFICATE OF EXPRESS MAILINGAssistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Specifically, accompanying this communication please find:

- (a) Transmittal by Express Mail
- (b) Postcard
- (c) Reply Under 37 CFR § 1.111.

Respectfully submitted,

Date: 8/9/2002

Bonnie FergusonALLERGAN, INC.
T2-7H
2525 Dupont Drive
Irvine, CA 92612
Tel: 714-246-4669
Fax: 714-246-4249